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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

POND, ROBERT M

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/828,796

Applicant(s)

HONG ET AL.

Examiner

Robert M. Pond

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

The Applicant amended Claims 1 and 9. All pending claims (1-12) were examined in this non-final Office Action necessitated by new grounds of rejection under 35 USC 101.

Response to Arguments

Objection to Abstract in the Specification

The Applicant amended the abstract to overcome the objection. Objection to the abstract is withdrawn.

Rejection under 35 USC 103(a)

Applicant's arguments filed 04 June 2004 have been fully considered but they are not persuasive.

- **The Applicant argues BBBOnline as taught by prior art BBB does not certify any number of individual claims made by a company about a product or service.**

The Applicant admits the difference between the prior art and the Applicant's invention is subtle and attempts to overcome the prior art by relying on a disclaimer in the prior art stating "it is important for you to remember that a business's participation in BBBOnline does not guarantee you will be satisfied with a product or service. While BBBOnline

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participants have satisfactory complaint handling records with Better Business Bureaus, this does not mean that they have never experienced complaints, not it is a guarantee that they won't in the future."

- Customer satisfaction is subjective based on an individual's perception about the performance of a product. Both BBBOnline's reliability assurance program and the Applicant's invention are subject to customer satisfaction perceptions.
- This Examiner firmly believes that the cornerstone for any product/service certification service must address the company's business practices else why bother certifying individual claims for product/service if the company's business practices are not trustworthy. For example, certifying a residential building's roof for 30 years is undermined by untrustworthy business practices by the construction company providing certifying the roof.
- Companies committing to BBBOnline are agreeing to comply with guarantees applying to business practices with respect to the products and services provided. In the Examiner's opinion, this creates a halo effect over the products and services provided. Please note that companies applying for a BBBOnline seal are asked to identify products/service through the registration process.
- BBBOnline's application form request descriptions of product and services (#6, U: see page 9), and shows Planetary Technologies

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web site with individual products (#6, U: see page 5). The point being that BBBOnline alone teaches or suggests a motivation to granularize certification to the product/service level. PRN teaches a product level certification service and is considered pertinent to the field of certification services.

- BBBOnline's business reliability assurance program offers remedies- the Applicant's invention offers remedies. As claimed, the Applicant's invention offers no more "teeth" in enforcing customer satisfaction than the cited prior art.
- BBBOnline's agreement contains terms, conditions, rights, liabilities, and remedies. It may not be the strongest contract but viewed to be sufficient to overcome the claimed subject matter of "entering into a contract."
- PRN teaches certification at the product level and certifies compliance to performance standards. The Examiner views certifying a product to comply with a standard the same as certifying the claim to be true. For instance, Product A complies with the required +10.0% volt-dc margin test for high voltage based on a nominal voltage of 10.0 volts DC. It is true that Product A can operate at 11.0 volts.

- *Neither BBB nor PRN suggest or make obvious "posting information on the Web page about the product or service in which said certain claims verified as true are prominently displayed."*

The Applicant is arguing prudent advertising business practices. BBB teaches the displaying of the BBBOnline Reliability Assurance Seal as an overarching seal of trustworthiness of the online business- just prudent advertising business practice and provides a list of participating online businesses.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. **Claims 1 and 5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

The claims are directed to a process that does nothing more than manipulate an abstract idea. Mere recitation in the preamble (i.e., intended use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea. There is no practical application in the technological arts to support the core invention. For subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea or mathematical algorithm

in the technological arts. See *In re Alappat* 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond V. Diehr*, 450 U.S. at 192, 209 USPQ at 10). A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result: i.e. the method recites a step or act of producing something that is concrete, tangible and useful. See *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ2d at 1452.

The claimed invention must utilize technology in a non-trivial manner. The board affirmed the rejection under U.S.C. 101 as being directed to non-statutory subject matter. The Board held that the disclosed and claimed invention is directed merely to a human making mental computations and manually plotting results on a paper chart, and thus is nothing more than an abstract idea which is not tied to any technological art and is not a useful art as contemplated by the Constitution (*Ex parte Bowman*, 61 USPQ2d 1665, 1671). Even though *Bowman* is not precedential, *Bowman* is cited for its analysis of whether the claims are in the technological arts.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 2. Claims 1-12 are rejected under 35 USC 103(a) as being unpatentable over BBB (Paper #6, PTO-892, Items: U), in view of PR Newswire (Paper #6, PTO-892, Item: V, hereinafter referred to as "PRN").**

BBB teaches the Better Business Bureau's reliability assurance program for the World Wide Web that serves as a regulatory service for businesses conducting electronic commerce so that consumers can find reliable, trustworthy businesses online. Qualified companies receive a seal that can be posted on their web site allowing shoppers to check BBB information on a company and be assured the company is reliable (please see at least pages 1-38). BBB further teaches:

- *Establishing a certification service:* bbbonline.com web page maintained for certification service (U: see pages 1 and 4).
- *Entering in to a contract between the certification service and provider:* application for contract requiring fees and adherence to Code of Online Business Practices that includes providing information about the

provider's business, accurate information about goods and services online (U: see at least pages 4 and 7-12).

- Verifying the claims made by the provider: provider completes application; physical site visit made by Better Business Bureau representative (U: see at least pages 7-12).
- Posting information on the Web page about the product or service: clicking on electronic seal on provider's web site provides information about provider's trustworthiness claims; selecting a provider from certification web page provides provider information via hyperlink (U: see at least page 2).
- Maintaining a database of providers: online list of participating providers (U: see at least pages 4 and 6).
- Providing a search engine: search engine: (U: see at least pages 4, 6).
- Rights and liabilities between service and provider: Code of Conduct includes guarantees by the provider with remedies else be removed from the approved list (U: see at least pages 15-31).
- Links to provider's certification information and claims: electronic seal links to provider's claim information and remedies using a web page (U: see at least pages 4, 5, and 12).
- Service directly rules over disputes: direct dispute resolution (U: see at least pages 12, 14, and 29).

- *Stand alone and existing business:* Please note examiner's interpretation: Better Business Bureau is an existing business sponsoring the certification service and is also a stand alone business separate from participating online providers.
- *Product or service level certification:*

BBB teaches all the above as noted under the 103(a) rejection and teaches a) certifying the trustworthiness of a participating provider about its business practices, customer service, and products and services based on a Code of Online Business Practices, and b) issuing an electronic seal for approved provider's web site that links to the provider's certification claims, but does not specifically disclose certifying one or more claims at the product or service level. PRN teaches product certification using the NEBS Level 3 standards that represent the highest ranking within Bellcore/Telcordia's telecommunications equipment compliance guidelines. PRN teaches the NEBS Level 3 verification certifies that the product meets the physical, electrical, and environmental requirements to safely and reliably operate within both new and existing carrier infrastructure, and has the capacity to withstand stresses of extreme temperature, humidity, fire, earthquakes, light, and noise. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of BBB to implement certification on individual

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products as taught by PRN, in order to ensure compliance, operability, and reliability in a product, and therefore attract shoppers to the service.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Mr. Vincent Millin** can be reached on 703-308-1065.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

703-872-9306 (Official communications; including After Final
communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

A handwritten signature in black ink, appearing to read 'R. M. Pond', with a stylized flourish at the end.

Robert M. Pond
Patent Examiner
September 7, 2004